

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael KOMOWSKI
Title: DRUM-TYPE VALVE
Appl. No.: 10/578,564
Filing Date: 08/15/06
Examiner: Samantha A. Miller
Art Unit: 3749
Confirmation No.: 9060

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Claims 1-4, 6, and 10-21 are rejected as allegedly being unpatentable over FR 2771966 ("Philippe")¹ and DE 10031991 ("Mueller"). This rejection is traversed.

Philippe and Mueller do not teach or suggest all the features of claims 1 and 11

No combination of Philippe and Mueller teaches or suggests the combination of features of claims 1 and 11. For example, neither Philippe nor Mueller teaches or suggests an externally surrounding rim, which projects perpendicularly outward from the circumferential surface along two edges of the circumferential surface that run along a longitudinal direction of the circumferential surface. Element 64 of Philippe (which the PTO considers to be the externally surrounding rim of claims 1 and 11) does not project perpendicularly outward from the circumferential surface along two edges of the surfaces 50 (which the PTO considers to be

¹ The Office Action refers to Philippe as "Pierre."

the circumferential surface of claims 1 and 11). Indeed, the element 64 of Philippe only projects from one edge of the surfaces 50. The PTO has asserted that Fig. 4 of Philippe shows element 64 extending “perpendicular and inward from surface 50.” (Advisory Action.) However, claim 1 and 11 states that the externally surrounding rim extends outward (not inward) and element 64 still does not extend along two edges of the surface 50. Thus, Philippe does not teach the externally surrounding rim of claims 1 and 11.

Mueller does not cure the deficiencies of Philippe. For example, Fig. 7 of Mueller merely shows an air flap with elements 14 and 17, and side walls 19. The air flap of Fig. 7 does not show an externally surrounding rim projecting perpendicularly outward from the circumferential surface along two edges of the circumferential surface that run along a longitudinal direction of the circumferential surface. The PTO asserts that element 14 of Mueller is equated with the externally surrounding rim of claims 1 and 11. (Page 4 of the Office Action.) However, this element 14 of Mueller does not project perpendicularly outward from region 12 of Mueller (which the PTO equates with the circumferential surface of claims 1 and 11) along two edges of region that run along a longitudinal direction of region 12. Element 14 of Mueller merely runs along one edge of the region 12 along the longitudinal direction of the region 12. Thus, element 14 of Mueller cannot be considered the externally surrounding rim of claim 1 or 11. The PTO seems to suggest that, when combined, the element 17 of Mueller is one edge and the element 64 of Philippe is another edge of the externally surrounding rim. However, the PTO’s analysis is incorrect on its face because element 64 of Philippe extends inward (not outward). Philippe and Mueller do not teach or suggest the externally surrounding rim of claim 1 or 11, and claims 1 and 11 are allowable.

Also, Philippe and Mueller do not teach or suggest a second rim projecting perpendicularly outward from the circumferential surface, the circle segment surfaces, or a combination thereof in which at least one segment (with at least one opening) is delimited by the externally surrounding rim and the second rim. The PTO asserts that the top and side edges of element 48 of Philippe are considered to be the second rim of claims 1 and 11. (Page 2 of the Office Action.) However, these top and side edges do not project perpendicularly outward from the surfaces 50 (which the PTO considers to be the circumferential surface of claims 1 and 11). (Fig. 4 of Philippe.) Indeed, the top and side edges of element 48 do not project outward from the surfaces 50. Thus, Philippe does not

teach or suggest at least a second rim projecting perpendicularly outward from the circumferential surface, the circle segment surfaces, or a combination thereof.

Mueller does not cure the deficiencies of Philippe. For example, Fig. 7 of Mueller merely shows an air flap with elements 14 and 17, and side walls 19. The air flap of Fig. 7 does not show a second rim projecting perpendicularly outward from the circumferential surface, the circle segment surfaces, or a combination thereof in which at least one segment (with at least one opening) is delimited by the externally surrounding rim and the second rim. The PTO asserts that element 17 of Mueller is equated with the second rim of claims 1 and 11. (Page 4 of the Office Action.) However, this element 17 of Mueller does not delimit with element 14 (which the PTO equates with the externally surrounding rim of claims 1 and 11) at least one segment with at least one opening. Thus, element 17 of Mueller cannot be considered the second rim of claim 1 or 11. Because Philippe and Mueller do not teach or suggest the second rim of claim 1 or 11, claims 1 and 11 are allowable.

Philippe and Mueller do not teach or suggest all the features of claims 13 and 17

Philippe and Mueller do not teach or suggest the combination of features of claims 13 and 17. For example and as previously mentioned, neither Philippe nor Mueller teaches or suggests an externally surrounding rim, which projects perpendicularly outward from the circumferential surface along two edges of the circumferential surface that run along a longitudinal direction of the circumferential surface. Thus, claims 13 and 17 are allowable.

Also, neither Philippe nor Mueller teaches or suggests a third region in which the second rim extends above the planar surface of the third region and runs substantially around the third region. The PTO correctly states that Philippe does not teach a third region. (Page 4 of the Office Action.) Mueller does not cure the deficiencies of Philippe because element 17 (which the PTO equates with the second rim of claims 13 and 17) does not runs substantially around the area where element 17 “meets the space between 12 and 12” of Mueller (which the PTO equates with the third region of claims 13 and 17). Thus, Philippe and Mueller do not teach or suggest the third region of claims 13 and 17, claims 13 and 17 are allowable.

Philippe and Mueller do not teach or suggest all the features of claim 21

No combination of Philippe and Mueller teaches or suggests the combination of features of claim 21. For example and as previously mentioned, Philippe and Mueller do not teach or suggest an externally surrounding rim projecting perpendicularly outward from the

circumferential surface along two edges of the circumferential surface that run along a longitudinal direction of the circumferential surface. Also, Philippe and Mueller do not teach or suggest a second rim projecting perpendicularly outward from the circumferential surface, the circle segment surfaces, or a combination thereof in which at least one segment (with at least one opening) is delimited by the externally surrounding rim and the second rim or a third region in which the second rim extends above the planar surface of the third region and runs substantially around the third region. Thus, claim 21 is allowable.

The combination of Philippe and Mueller is improper

Philippe discloses a heating/ cooling device which includes a housing 10 defining an internal chamber 16 suitable to be fed by a stream of air and communicates with a first outlet 32, a second outlet 34 and a third outlet 38. (Fig. 1 of Philippe.) A single drum-type flap 20 is mounted for rotation about an axis XX, and has two side flanges 48 joined by a circular cylindrical wall 50. (Fig. 4 of Philippe.) The cylindrical wall 50 is provided with openings and for channeling air to the first outlet 32, the second outlet 34, and the third outlet 38. (Abstract of Philippe.) Figs. 1-2 show how the flap 20 channels air uses the openings in the cylindrical wall 50 to channel air into the various passages.

The PTO asserts that it would have been obvious to incorporate the air guidance element 18 of Mueller (with its elements 14 and 17 and “the portion between the elements 12 and 12”) into the flap of Philippe “in order to stop the rotation of the valve and in order to make possible also a lateral air circulation and seal.” (Page 5 of the Office Action.) A rejection based on this modification is improper. MPEP 2143.01 states that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” In this case, the addition of the air guidance element 18 into cylindrical wall 50 of Philippe would cover up the openings along the cylindrical wall 50 of Philippe when the “portion between elements 12 and 12” of Mueller is placed in between the flanges 48 and 48 of Philippe. With the openings of Philippe covered up, the flap 20 of Philippe is no longer suitable for channeling air to the first outlet 32, the second outlet 34, and the third outlet 38. If the flap 20 of Philippe cannot channel air to these passages as a result of the modification, the proposed modification makes the flap of Philippe unsuitable for its intended purpose. The PTO contends that “the

combination would teach a solid section and a section of openings of the arch section.” (Advisory Action.) However, because the combination intends to incorporate the air guidance element 18 with its air guide surfaces 14 and 17 and the intermediate section 12, there is no basis to conclude that the air guide element 18 would have holes since its own function as an air guide element would be otherwise compromised. As a result, the rejection is improper.

Furthermore, the rejection based on the incorporation of the air guidance element 18 of Mueller in the flap 20 of Philippe is improper because it changes the principle of operation of the flap of Philippe. MPEP 2143.01 provides “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” In this case, the openings in the cylindrical wall 50 of Philippe channel air into the first outlet 32, the second outlet 34, and the third outlet 38. Mueller uses the air guidance element 18, which has no openings. The cylindrical wall 50 of Philippe and the air guidance element 18 of Mueller work on such different principles of air flow control that the use of one necessarily changes the principle of operation of the other. Because the proposed modification of the air guidance element 18 of Mueller changes the principle of operation of the flap 20 of Philippe, the rejection is improper.

Allowability of dependent claims

Claims 2-4, 6, 10, 12, 14-16 and 18-20 are allowable by virtue of their dependency from claim 1, 11, 13, or 17.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date 4/28/2010

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6162
Facsimile: (202) 672-5399

By Matthew J. Kremer

Pavan K. Agarwal
Registration No. 40,888

Matthew J. Kremer
Registration No. 58,671